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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,188	05/09/2001	Ilham Mohamed Saleh Saeed Abuljadayel	674528-2003.1	6161

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NEW YORK, NY 10151

EXAMINER
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CANELLA, KAREN A

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 06/03/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/853,188</b>	Applicant(s) <b>Abuljadayel</b>	
Examiner <b>Karen Canella</b>	Art Unit <b>1642</b>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on \_\_\_\_\_.

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-100 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims 1-100 are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Claims 1-100 are pending.
2. After review of the Restriction Requirement of Paper No. 10, it was noted that claims 98-100 were overlooked. Accordingly, the restriction requirement of Paper No. 10 is vacated.

#### *Election/Restriction*

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-41, drawn to a device for forming or increasing the relative number of undifferentiated cells in a cell population, classified in class 435, subclass 284.1.
  - II. Claims 42-97, drawn to a method for preparing an undifferentiated cell comprising retro differentiating a more committed cell to a less committed cell, classified in class 435, subclass 377.
  - III. Claims 98-100, drawn to a business method comprising supplying a device as claimed in any of claims 1-4 and/or means that are capable of causing a committed cell to retro differentiate into an undifferentiated cell, classified in class 705, subclass 500.
4. The inventions are distinct, each from the other because of the following reasons:

The methods of Groups II and III differ in the method objectives, method steps and parameters and in the reagents and supplies used.

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus of Invention I can be used in a method of preparing a transformed cell line.

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Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the device of Group I can be used in the method of Group II or the method of Group III.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because the searches required for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Claims 1-100 are generic to a plurality of disclosed patentably distinct species comprising

- A. (i) Hematopoietic cells,
- (ii) neuronal cells,
- (iii) epithelial cells,

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- (iv) mesenchymal cells,
- (v) endodermal cells,
- (vi) embryonic cells;
- B. (i) CD34<sup>+</sup> cell surface marker,
- (ii) HLA-DR cell surface marker,
- (iii) CD38<sup>-</sup> cell surface marker,
- (iv) CD117 cell surface marker,
- (v) AC113 cell surface marker,
- (vi) CD90 cell surface marker,
- (vii) CD45low cell surface marker;
- C. (i) CFC-T cells and T-cells,
- (ii) CFC-B cells and B-cells,
- (iii) CFC-Eosin cells,
- (iv) CFC-Bas cells,
- (v) CFC-GM cells,
- (vi) CFC-MEG cells,
- (vii) CFC-E cells.

9. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from Group A, and a single disclosed species from Group B even though this requirement is traversed. In the event that applicant elects hematopoietic cells from Group A, an additional election from Group C is required.

10. Should applicant traverse on the ground that the species are not patentably distinct, **applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case.** In either

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instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*Karen A. Canella*  
Karen A. Canella, Ph.D.

Patent Examiner, Group 1642

June 2, 2003